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| 09/963,267      | 09/26/2001  | Haruo Hyodo          | 10417-101001        | 8383             |

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EXAMINER

SOWARD, IDA M

ART UNIT

PAPER NUMBER

2822

DATE MAILED: 02/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/963,267

Applicant(s)

HYODO ET AL.

Examiner

Ida M Soward

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to a semiconductor device, classified in class 257, subclass 678.
- II. Claims 4-7, drawn to a semiconductor device manufacturing method, classified in class 438, subclass 1+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the semiconductor device could have formed by a different set of processes resulting in the same structure.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Chris T. Mizumoto on 02/05/02 a provisional election was made without traverse to prosecute the invention of a semiconductor device, claims 1-3. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-7 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

Figures 9A and 9B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference sign 4 (an element mounting portion). A proposed drawing

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correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figures 9A-9B in view of Sasano (US 6,313,525 B1).

Prior Art Figures 9A-9B teach a semiconductor device comprising: a supporting substrate **1** made of insulating material; three conductive patterns provided on a surface of the supporting substrate; an external connecting terminal **2** electrically connected to the conductive patterns; a semiconductor circuit element **5**; and a ceramic plate **3** that covers the circuit element and that forms a hollow airtight portion **7** between the supporting substrate and the ceramic plate. However, Prior Art Figures 9A-9B fail to teach a glass plate, an external connecting terminal provided on a back surface of the supporting substrate, and an adhesive resin applied to an overall adhered surface of the glass plate. Sasano teaches a glass plate **9** with an adhesive resin **10** applied to an overall adhered surface of the glass plate and an external connecting terminal **6** provided on a back surface of the supporting substrate (Figure 1, column 6, lines 6-10).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device structure of Prior Art Figures 9A-9B with the glass plate, adhesive and external connection of Sasano to maintain air tightness.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figures 9A-9B and Sasano (US 6,313,525 B1) as applied to claim 1 above, and further in view of Toshiba KK [Toke] (JP07225391A).

Prior Art Figures 9A-9B and Sasano teach all mentioned in the rejection above. However, Prior Art Figures 9A-9B and Sasano fail to teach a light-shielding adhesive resin. Toshiba KK [Toke] teaches a light-shielding adhesive resin. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device structure of Prior Art Figures 9A-9B and the glass plate, adhesive and external connection of Sasano with the light-shielding adhesive resin of Toshiba KK [Toke] to eliminate undesirable device operation caused by unwanted light.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art respect to a semiconductor circuit element housed on a supporting substrate sealed by an airtight cap:

Butera (US RE37,082 E)

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Erickson (6,020,633)

Hirose et al. (5,898,218).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ida M Soward whose telephone number is 703-305-3308. The examiner can normally be reached on Monday - Friday, 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead, Jr. can be reached on 703-308-4940. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

ims  
February 8, 2002

  
**CARL WHITEHEAD, JR.**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**